

REMARKS

Claims 1-15 are pending in the application.

Claims 1-15 stand rejected.

Claims 1 and 7 have been amended.

Double Patenting

Claim 1-6 are provisionally rejected, under the judicially-created doctrine of double patenting, over claims 1 and 5-7 of copending Application No. 09/663,252. The Office Action notes that this is a provisional double patenting rejection since the conflicting claims have not yet been patented. A terminal disclaimer to alleviate the double patenting rejection accompanies this response. Applicant therefore respectfully submits that this basis of rejection is overcome thereby.

Rejection of Claims under 35 U.S.C. §103

Claims 1-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Vrhel, Jr. et al., U.S. Patent No. 6,543,047 (Vrhel, Jr.). Applicant respectfully disagrees.

Applicant respectfully submits that the particular parts of the cited references that the Office Action relies upon have not been designated as nearly as practicable, as required by 37 C.F.R. § 1.104(c)(2). In particular, the citation of “col. 2, line 32 et seq” is unclear as to its extent. Nevertheless, Applicant has made every attempt to respond to the rejections recited in the Office Action. Applicant assumes for this purpose that the paragraph beginning at col. 2, line 32 (col. 2, lines 32-45) is the portion of Vrhel cited.

Applicant also respectfully submits that the rejection of claims 1 and 7 lack the requisite particularity, as required in same regard noted above. Applicant respectfully notes that the Office Action incorrectly equates the limitations of claim 1 with those of claim 7, in rejecting claim 7 under 35 U.S.C. §103(a). As can be seen in the listing of these claims provided herein, various limitations recited in each of these claims differ noticeably from those of the other. The elements of claims 1 and 7 are noticeably different, and thus a rejection of one of these claims would not necessarily apply to the other. Applicant is thus at a loss to understand how each of the elements of claim 1 can be characterized as corresponding to each of those of claim 7. Nevertheless, Applicant again respectfully submits that Applicant has made every attempt to respond to the rejections recited in the Office Action.

Applicant respectfully submits that the claimed invention is not made obvious by Vrhel, either taken alone or in permissible combination with other references or skill in the art at the time of invention. As an initial matter, Applicant respectfully submits that the rejection lacks the requisite clarity. The Court of Appeals for the Federal Circuit has set forth requirements for rejections based on 35 U.S.C. § 103, which Applicant respectfully submits have not been met in at least the rejection of independent claims 1 and 7. "To reject claims in an application under section 103, an examiner must show an un rebutted prima facie case of obviousness. In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent." *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir 1998) (citations omitted). Applicant respectfully submits that the rejection fails to meet the requirements set forth, as the rejection is not clear as to the elements of Vrhel that correspond to the claimed elements. Applicant therefore respectfully requests

clarification of the rejection as to the correspondence between the elements of Vrhel and those of the claimed invention, as claimed in claim 1. Applicant also respectfully requests that the correspondence between the elements of Vrhel and those of the claimed invention, as claimed in claim 7, also be demonstrated.

As to the rejection of claim 1, Applicant respectfully submits that the claimed invention is not made obvious by Vrhel, either taken alone or in permissible combination with other references or skill in the art at the time of invention. Applicant respectfully submits this is so because, as an initial matter, Vrhel is directed to a build-to-order system, while the claimed invention is directed to a method for allocating processing resources. First, Vrhel's disclosure is not in an art analogous to that of the claimed invention, and, as discussed in MPEP 1504.03, which states that a rejection under 35 U.S.C. 103(a) based on a single non-analogous reference would not be proper, because a designer of ordinary skill would not be charged with knowledge of prior art that is not analogous to the claimed design. Thus, Applicant respectfully submits that the rejection is improper.

Even if the rejection were proper, the above distinction is determinative. Vrhel is concerned with the construction of a computer system from component parts, and the installation of software on the then-assembled computer. (col. 2, lines 24-45) The claimed invention, in contrast, is directed to the configuration of existing hardware and software (although Applicant notes that, in fact, the claimed invention is also capable of installing software on existing hardware). This distinction is apparent because of the recitation of "processing resources", which conveys the fact that such items exist, and simply need to be configured.

In order to emphasize these and other distinctions, Applicant has amended claim 1, as well as claim 7. Claim 1 now recites that the processing resources are allocated, which conveys that the processing resources exist prior to the displaying, accepting and configuring that are then performed.

A similar distinction exists with regard to claim 7, which recites the elements that go to make up a computing environment, which, in specific, comprises a communication link, hardware devices (coupled to the communication link) and software programs (coupled to the hardware devices). First, as will be appreciated, the configuration of such elements into a computing environment requires that these elements pre-exist the computing environment, so that they may be configured to form the computing environment.

Moreover, Vrhel in no way shows, teaches or suggests either a computing environment, nor an apparatus that can be configured to form such a computing environment. This is, again, due to the fact that Vrhel is focused on a manufacturing process for building computers to order for customers, and so is not concerned with forming such a computing environment via the configuration of the recited elements. (col. 2, lines 24-45)

The Office Action correctly notes that Vrhel does not teach that the user uses an input device to indicate the selected processing resource. However, the Office Action continues, stating that the claimed display and selection would be obvious to one of skill in the art, “when ordering on-line”. The claimed invention is not concerned with on-line ordering of built-to-order computers, as is the subject of Vrhel’s disclosure. (col. 2, lines 24-45) One of skill in the art, at the time of invention, could therefore not be expected to


look to Vrhel to teach the configuration of an (existing) communication link, (existing) hardware devices and (existing) software programs, because Vrhel is concerned not with the configuration of such (existing) elements, but with determining the requirements of a customer's order for a (yet-to-be-built) built-to-order computer. (col. 2, lines 24-45)

For at least the foregoing reasons, Applicant respectfully submits that the invention, as claimed in independent claims 1 and 7, is not made obvious by Vrhel. Applicant further respectfully submits that claims 2-6 and 8-15, which depend from independent claims 1 and 7, are also not made obvious by Vrhel for at least the foregoing reasons. Applicant therefore respectfully submits that claims 1-15 are in condition for allowance.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5084.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 24, 2004.



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3/24/04

Date of Signature

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